

## What Make's An Invention Patentable for Being Sufficiently "Unobvious" Under U.S. Patent Law?

As most entrepreneurs have learned or will learn as they pursue new business paths, one of the many requirements for patenting an invention in the U.S. is the "obviousness test." Patent applications that fail this test are unpatentable in the U.S. The obviousness test is a very complicated legal test, and it is widely misunderstood.

One aspect of that misunderstanding is reflected in the common statement that the obviousness test determines whether *"the invention"* would have been obvious to any ordinary artisan at the time of invention by the inventor. The error here is that it is **NOT** the *"the invention"* that must have been obvious. Rather, as stated expressly in 35 U.S.C. Section 103, it is the inventor's *"claimed subject matter as a whole"* that must have been "obvious" within the unique meaning of these terms under the patent law. Under the patent laws, the *"claimed subject matter as a whole"* includes not just (i) the exact claimed combination of elements identified as the invention in the patent application, but also (ii) the advantages and functions of that claimed combination, and (iii) when applicable, the inventor's discovery of the problem to be solved by the claimed combination. Frequently, it is these latter aspects of the *"claimed subject matter as a whole"* that were most clearly unobvious at the time of the invention.

Thus, even when an inventor's invention is simple or even technically trivial, the invention usually should be patentable in the U.S. provided that advantages or functions provided by the invention were unobvious, or the problem to be solved by the invention was unobvious, prior to the inventor's first development of the invention. Again, this is because it is the *"claimed subject matter as a whole"* that must have been unobvious. When a substantial component of the *"claimed subject matter as a whole"* -- such as the problem to be solved or advantages or functions to be provided by the inventor's solution -- was unobvious at the time the inventor invented the solution, then the *"claimed subject matter as a whole"* should also be considered unobvious under U.S. patent law. In this circumstance, the claimed subject matter (the combination asserted to be the invention in the patent application) should therefore be patentable notwithstanding the simplicity or predictability of the inventor's solution in hindsight.

If you think about it, this is all as it should be. The purpose of the U.S. patent laws is to stimulate innovation and expansion of human knowledge. This stimulation is served by providing patenting opportunities for discovery of unobvious problems and providing unobvious advantages or functions through the invention. The lack of technical complexity or predictability of the operation of components in the resulting invention are not, and should not be, the sole determining factors in the obviousness inquiry. They are not when one considers the *"claimed subject matter as a whole"* and all of its components under Section 103 of the U.S. Patent Act.

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